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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/517,364 | 03/02/2000 | B. Scott Fabre | SLA0153:FCO | 5185 |
| 26790 | 7590 | 01/27/2006 | EXAMINER | |
| LAW OFFICE OF KAREN DANA OSTER, LLC PMB 1020 15450 SW BOONES FERRY ROAD #9 LAKE OSWEGO, OR 97035 | | | DONAGHUE, LARRY D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2154 | |

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/517,364

Applicant(s)

FABRE, B. SCOTT

Examiner

Larry D. Donaghue

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 7, and 9-24 is/are rejected.
7) ☒ Claim(s) 6 and 8 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. Claims 1-24 are presented for examination.
2. Applicant's arguments, see page 9, 2nd paragraph, filed 10/17/2005, with respect to 112 1st have been fully considered and are persuasive. The rejection of claims 6 and 8 has been withdrawn.
3. Claims 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1,2,3, 9,10,12,13, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson et al. 6,819,455 in view of Carpentier et al. (2005/0172124).

Stevenson et al. taught the invention substantially as claimed the invention (claim 1,2 and 21) as claimed including a method for executing a request to print said "print portion" (col. 3, lines 26-35); generating a "print portion" uniqueness identifier in a host computer, said "print portion" uniqueness identifier specifically referring to and for identifying said "print portion" (col. 3, lines 36-50); comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory (col. 1, lines 62-67, col. 3, lines 52-64); printing said "print portion" using previously rendered data stored in a memory location referenced by said list of uniqueness identifiers if said "print portion" uniqueness identifier is found in said list of uniqueness identifiers (col. 3, lines 52-64); and storing said "print portion" uniqueness identifier and a reference to data stored in memory pertaining to said "print portion" in said list of uniqueness identifiers if said "print portion" uniqueness identifier is not found in said list of uniqueness identifiers (col. 4, lines 12-25).

Stevenson did not expressly teach calculating a uniqueness identifier, Carpentier et al. taught calculating a uniqueness identifier (encrypting File name) (para. 016, abstract) it would have been obvious to one of ordinary skill in the art to combine these references as it would allow the files as taught by Stevenson et al. to be safely stored or transferred within a network and is uniquely identifiable by its IUI, as expressly taught by Carpentier et al .

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As to claim 3, Stevenson et al. taught printing said "print portion" printing an entire print job (col. 3, lines 52-64).

As to claims 9, 12, and 22, Stevenson et al. taught comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory further comprising the step of comparing said "print portion" uniqueness identifier to a list of uniqueness identifiers stored in memory in a printer (col. 3, lines 37-50).

As to claim 10, 13, and 23, Stevenson et al. taught transferring said "print portion" uniqueness identifier from said host computer to said printer (col. 3, lines 37-50).

Claims 4, 5, 7, 8, 11, 14, 15-20, and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson et al. (6,819,455) and Carpentier et al. (2005/0172124) as applied to claims 1,2,3,, 9,10, 12,13, 21-23 above, and further in view of Mastie et al. (6,498,656).

As to claims 11, 14 and 24, Stevenson et al. in combination with Carpentier et al. did not teach transferring all or part of said "print portion" from said host computer to said printer if said "print portion" uniqueness identifier is not found in said list of uniqueness identifiers. Mastie et al. suggest the modification as it would reduce network traffic (col. 6, line 49- col. 7, line 11).

As to claims 4, 5, 7, and 15-20, Stevenson et al. did not expressly teach taught printing said "print portion" printing a portion of an entire print job. Mastie et al. suggest the modification, segmenting print jobs into multiple files (col. 6, lines 49-57).

Claims 5 and 7 are multiple file version of claims 1,2, and 21 are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 1,2, and 21.

Claims 15 and 18 are multiple file version of claims 9, 12 and 22 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 9,12 and 22.

Claims 16 and 19 are multiple file version of claims 10, 13 and 23 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 10,13 and 23.

Claims 16 and 20 are multiple file version of claims 11, 14 and 24 and are rejected for the reason set forth in the rejections set forth in the rejection of claims 4 and 11,13 and 24.

6. Applicant's arguments filed on 10/17/2006 have been fully considered but they are not persuasive.

7. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments fail to take into account the combined teachings as a whole.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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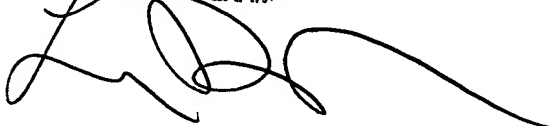
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LARRY D. DONAGHUE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'L. Donaghue', written over the printed name and title.